

Page 12
Serial No. 10/662,599
Response to Official Action

In the Drawings

Attached hereto on separate sheet, please find amended Fig. 4.

Remarks

Applicant has amended Claim 1 and added new Claims 46 and 47. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has objected to Claim 29. The Examiner has rejected Claims 20 – 21 under 35 U.S.C. §112, first and second paragraphs. The Examiner has further rejected Claims 19 – 27 and 29 – 31 under 35 U.S.C. §102(a) as anticipated by U.S. Patent No. 6,411,851 to Winkler (“the ‘851 patent”). The Examiner has still further rejected Claim 28 under 35 U.S.C. §103(a) as being unpatentable over the ‘851 patent in view of U.S. Published Application No. 2002/0193676 to Bodicker et al. (“the ‘676 application”). These rejections are respectfully traversed.

Claim Objections

Applicant has amended Claim 29 to address the Examiner’s objection.

35 U.S.C. §112, First & Second Paragraphs Rejections

Applicant has amended paragraph 51 of the written specification and Fig. 4. Applicant submits that no new matter was added by this amendment as this matter was previously described in the originally filed written specification. (See, Claims 20 – 21).

35 U.S.C. §102(a) Rejections

As amended, Claim 19 requires among other limitations, a medical video instrument having touch screen control, a touch screen for entering control commands to control the medical video instrument, and a processor for receiving the control commands and for generating control signals to operate the medical video instrument. Applicant respectfully submits that these limitations are not disclosed in the '851 patent.

The '851 patent is directed toward a “portable programming apparatus for use with an implantable medical device.” (Abstract). The '851 patent fails to disclose a medical video instrument or control and operation of a medical video instrument as required by amended Claim 19. For example, the '851 patent discloses that “auxiliary components 216 includes stylus 208, magnetic programming head 218 and plurality of patient ECG leads 220.” (Col. 12, lines 54 – 56). The '851 patent further discloses that “[a]uxiliary components 216 are in no way limited to stylus 208, magnetic programming head 218, and patient ECG leads 220” but that “[r]egardless, auxiliary components 216 are configured to assist in programming IMD 10 previously discussed.” (Col. 12, line 66 – Col. 13, line 7). The Implantable Medical Device “IMD 10” may comprise for example, “implantable cardiac pacemakers.” (Col. 1, line 8; Col. 4, lines 66 – 67).

Therefore, the medical instrument that is being programmed (“controlled”) is not a medical video instrument are required by Claim 19. Accordingly, Applicant respect-

fully submits that because the '851 patent fails to disclose a medical video instrument having touch screen control, a touch screen for entering control commands to control the medical video instrument, and a processor for receiving the control commands and for generating control signals to operate the medical video instrument as required by Claim 19, the '851 patent cannot anticipate Claim 19.

Applicant further respectfully submits that Claim 19 is not obvious in view of the '851 patent. While, the '851 patent is directed to a "portable programming apparatus for use with an implantable medical device", the presently claimed invention is directed toward a system for controlling a medical video instrument. These are very different applications. The implantable medical device is not a medical video instrument, that may be used, for example, during a surgery, but rather a device that is permanently implanted into the body to regulate a vital body function. There is no video feed from the implantable medical device, nor can the IMD be modified to provide a video feed.

It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the intended purpose of the IMD taught in the '851 patent is to regulate a vital body function, while the programming apparatus 200 allows a user to program the IMD by means of programming head 218. Modification of the IMD to instead provide a video feed to a physician performing a surgical procedure would destroy the purpose of the

IMD. Accordingly, such a modification according to presently pending Claim 19, cannot be obvious.

Applicant further respectfully submits that the '851 patent fails to teach, disclose or suggest that the medical video instrument generates video data that is displayed on the touch screen, as required by Claim 46; or a video screen coupled to the processor, and where the medical video instrument generates video data that is displayed on the video screen, as required by Claim 47.

Rather, the touch screen taught in the '851 patent is a programming interface for the user to program the IMD. Nowhere, however, does the '851 patent teach, disclose or suggest any type of video is provided to the user to be displayed on either the touch screen or any other screen for that matter.

It is respectfully submitted that claims 19 – 31 and 46 – 47, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155